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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/818,771 03/14/97 MIRASHRAFI

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LMC1/0911
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EXAMINER

NGUYEN, S

ART UNIT

PAPER NUMBER

2731

13

DATE MAILED:

09/11/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/818,771

Applicant(s)

Mirashrafi et al.

Examiner

Steven Nguyen

Group Art Unit

2731



☒ Responsive to communication(s) filed on May 30, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-3, 5-11, 13-25, 29, and 30 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-3, 5-11, 13-25, 29, and 30 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Response to Arguments

1. In view of the appeal brief filed on 5/30/2000, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (a) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (b) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Response to Amendment

2. This action is in response to the amendment B filed on 5/30/00. Claims 5, 12, 26-28 and 31-32 have been canceled and claims 1-4, 6-11, 13-25 and 29-30 are pending in the application.

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Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1-3, 19-21, 24 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Radziewicz (USP 5854897).

Regarding claims 1-3, Radziewicz discloses (Fig 1-8, Col 1, lines 10 to col 34, lines 55) a server (Fig 1, Ref 16 such as AOL) for receiving a request from the client system (Fig 1, Ref 14, client system) to a target server (Fig 1, Ref 12, target server), providing addition information (Fig 1, Ref 30 provides advertisement information to Ref 16) from server and information from the target server to the client system (See col 4, lines 49-57, col 6, lines 56-64, col 7, lines 25-26, col 12, lines 1-55, col 14, lines 20 to col 15, lines 59).

Regarding claims 19-21 and 24, Radziewicz discloses (Fig 1-8, Col 1, lines 10 to col 34, lines 55) a server (Fig 1, Ref 16) for providing a control logic for receiving a request for content from the client system (Fig 1, Ref 14) targeting a network server (Fig 1, Ref 12) checking whether an addition content inquiry is to be provided to the client system along with the content which provides by the network server, content adding logic (Fig 1, Ref 30) which coupled to the control logic for providing the additional content to the client system if it is to be additionally

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provides (See col 4, lines 49-57, col 6, lines 56-64, col 7, lines 25-26, col 12, lines 1-55, col 14, lines 20 to col 15, lines 59).

Regarding claim 29, Radziewicz discloses (Fig 1-8, Col 1, lines 10 to col 34, lines 55) a client system (Fig 1, Ref 14) which comprises a control logic to transmitting a request that target a network server (Fig 1, Ref 12) and retransmit the request in the mark up form upon receiving a return of request from a bridge server (Fig 1, Ref 16) (See Fig 1, the client system 14 transmitting a request that target a server 12 via Internet service provider 16; after receiving a marked up form from the Internet service provider 16, the client clicks on the markup request to access the information, See col 4, lines 49-57, col 6, lines 56-64, col 7, lines 25-26, col 12, lines 1-55, col 14, lines 20 to col 15, lines 59).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 4, 6-11, 13-18, 22-23, 25 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Radziewicz as applied to claim 1, 19, 24 and 29 above, and further in view of Gabber (USP 5961593) and Rondeau (USP 5850433).

Regarding claims 4, 6-11 and 13-18, Radziewicz discloses in addition to the features set forth in the claimed invention. However, Radziewicz fails to disclose an additional content is a telephone number which allow a user to contact with the customer's representative and method of removing the mark up requests before forwarding the request to target server. However, Rondeau discloses an addition content includes an option for making a telephone call without requiring provision of a telephone number by a user and termination of current client system to network communication; automatically establishing a telephone to PSTN hand set; providing an URLS hyper text link (marked URLS) to the client system so that the client can access the web site of addition content by click on the hot spot such underline hyper link, an image etc . . . Furthermore, returning a marked version of the request to the client system; when the user clicks on the marked version, the ISP checks which proxy server has stored a current information and removing the marked version which provides at the current proxy server marked the request (Col 1, lines 1 to Col 16, lines 12) returning an HTML page to client system which includes marked version of the request, a marked identifier of the additional content, the request, identifier of additional content, and addition content. For example, when the client searches for a product, the

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ISP generates an HTML page which contains a marked version of the request such as highlight URLs or words and a marked identifier of additional content such as telephone Icon, Hyper text link host spot etc . . . ; Gabber discloses a method of removing the mark up requests before forwarding the request to target server (Fig 6).

Since the method of creating a hyper link or button with a telephone number is well known in the art as taught by Rondeau. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply Rondeau's teaching and a method of removing a mark up tag before transmitting a request to a target server as taught by Gabber into the method of Radziewicz. The suggestion/motivation would have been to reduce the cost of consumer access fees.

Regarding claim 22, Radziewicz fails to disclose a method of allowing the user automatically to establish a voice call to a PSTN handset in response to select an additional content by a user. However, in the same field of endeavor, Rondeau discloses a method of allowing the user automatically to establish a voice call to a PSTN handset in response to select an additional content by a user (See Abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method of embedded a telephone number into a button to allow the user to contact the customer's representative as taught by Rondeau into the Radziewicz' method. The motivation would have been to allow the customer interactive to a customer representative right away, if the customer does not satisfy with a detail description on the web page.

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Regarding claims 23 and 25, Radziewicz fails fully to disclose a control logic which marks up the request and return the request to client system for resubmitting, after receiving the marked up, remove the mark up request then forwarding the request to target server. However, Gabber discloses a method of removing the marked up before forwarding the request to target server (Fig 6, disclose a marked up tag removed before forwarding to the target server).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method of removing the marked tag as taught by Gabber et al into Radziewicz' method. The motivation would have been to provide anonymous retransmission of browsing command by the client system.

Regarding claim 30, Radziewicz fails fully to disclose the claimed invention. However, Rondeau discloses a method of allowing the client to transmitting another request after receiving an identifier of the additional content from the bridge server (After receiving a search report the client clicks on the telephone icon to speak with a representative or can click on the Hot link which has an address of the another web sites to access the advertisement is well known in the art by using HTML, See Abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method of embedded a telephone number into a button to allow the user to contact the customer's representative as taught by Rondeau into the Radziewicz' method. The motivation would have been to allow the customer interactive to a customer representative right away, if the customer does not satisfy with a detail description on the web page.

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Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham, can be reached on (703) 305-4378.

The fax phone number for this group is (703) 305-3988.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Steven Nguyen
Art Unit 2731
September 10, 2000



CHI H. PHAM
SUPERVISORY PATENT EXAMINER
GROUP 2700

9/11/00